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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 10/086,014              | 02/28/2002  | Andrea Hughes-Baird  | 0112300-610         | 3796             |
| 29159                   | 7590        | 03/09/2004           | EXAMINER            |                  |
| BELL, BOYD & LLOYD LLC  |             |                      | MOSSER, ROBERT E    |                  |
| P. O. BOX 1135          |             |                      | ART UNIT            | PAPER NUMBER     |
| CHICAGO, IL 60690-1135  |             |                      | 3714                |                  |
| DATE MAILED: 03/09/2004 |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                           |                    |
|------------------------------|---------------------------|--------------------|
| <b>Office Action Summary</b> | Application No.           | Applicant(s)       |
|                              | 10/086,014                | HUGHS-BAIRD ET AL. |
|                              | Examiner<br>Robert Mosser | Art Unit<br>3714   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2,4</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Webb et al (US 6,632,141).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Webb et al teaches a gaming device comprising a plurality of values; a plurality of player selectable masked selections; a display device; and a processor adapted to associate values with selections, enable a player to select one of the selections, reveal the value associated with the selection, enable the player to accept or reject the selection, and allow the player repeat this selection process at least once if they reject

the initial selection (Figures 1-3, & Abstract) as presented in at least claims 1, .11, 18 and 19

Webb et al teaches the random selection of values from a pool for association with the selections (Col 6:49-53) as recited in at least claims 2 and 3.

Webb et al teaches the number of values being equal to, greater than, or less than the number of selections (Col 6:66-7:7) as claimed at least in claims 4 through 6.

Webb et al teaches the association of an offer (value) with each symbol (selection) each time the player is allowed to make a selection or equivalently after the player has rejected zero selections or one selection (Col 6:41-48) as presented in at least claims 7 and 8.

Webb et al teaches the association of an offer (value) with only one or a plurality of symbols (Col 7:2-7) as claimed in at least claims 9 and 10

Webb et al teaches the random determination of an offer with a selection prior to each selection by the player (Col 6:45-48) and the display of the value associated with a selection after a selection is made (Col 7:11-12). It is the examiner's interpretation that this constitutes the "shuffling" of selections resultant of the display of at least one of the values associated with a selection as so claimed in at least claims 11 and 21.

Webb et al teaches the displaying of the award values present in the set including all of the values present, the highest value present, and the lowest values present (Col 7:8-17), and a plurality of randomly associated values as claimed in at least claims 12-17.

Webb et al teaches the re-revealing of a revealed value during the operation of the game wherein in it is the examiner's interpretation that the display of the values present in the prize set laid forth above serves as a first revealing and the revealing upon the selection of the selection serves to be a second revealing thus constituting a re-revealing as so claimed in at least claim 17 and 21.

Webb et al teaches awarding the selection to the player if the selection is not rejected or is their last selection (Col 8:28-30) as so claimed in at least claim 19.

Webb et al teaches the revealing of the offer associated with the selection as laid forth above. As this offer is the only offer associated with a selection during a stage of the game it represents the maximum offer and therefore the revealing of the offer associated with a selection is also the revealing of the maximum offer as presented in at least claim 20.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 11-17, and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Webb et al (US 6,632,141).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Webb et al discloses a selection game including a plurality of values, a plurality of player selectable selections, a display device, and a processor. The processor in communication with the display device and which associates said values with said

selections, displays to the player the association between at least one of the values associated with one of the selections, enables the player to select one of the selections and provides the player the value associated with the selected selection as presented in the rejection under 102 rejection above.

Webb et al however may be considered silent on the process of displaying shuffling under an alternative interpretation of the claims as presented. The randomizing of Webb et al serves the process of shuffling as described above and would produce the same result in game play. The displaying of the shuffling or mixing of the selections with their associated values is deemed a matter of design choice wherein no stated problem is solved or unexpected result is obtained. It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated the feature of displaying of the shuffling or mixing of the selections with their associated values in order demonstrate to the user that the process of randomizing is taking place or in the alternative allow the player to believe that may track the outcome of the randomization process visually.

Webb et al teaches the random determination of an offer with a selection prior to each selection by the player (Col 6:45-48) and the display of the value associated with a selection after a selection is made (Col 7:11-12). It is the examiner's interpretation that this constitutes the "shuffling" of selections resultant of the display of at least one of the values associated with a selection as so claimed in at least claims 11 and 21.

Webb et al teaches the displaying of the award values present in the set including all of the values present, the highest value present, and the lowest values

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present (Col 7:8-17), and a plurality of randomly associated values as claimed in at least claims 12-17.

Webb et al teaches the re-revealing of a revealed value during the operation of the game wherein in it is the examiner's interpretation that the display of the values present in the prize set laid forth above serves as a first revealing and the revealing upon the selection of the selection serves to be a second revealing thus constituting a re-revealing as so claimed in at least claim 17 and 21.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wood et al (US 5,511,781) teaches a stop play award wagering system with a selection feature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



JESSICA HARRISON  
PRIMARY EXAMINER